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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/562,093

12/21/2005

Fernando Incertis Carro

FR920030035US1

8123

30449 7590 07/21/2009
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EXAMINER

NGUYEN, MAIKHANH

ART UNIT

PAPER NUMBER

2176

MAIL DATE

DELIVERY MODE

07/21/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/562,093	Applicant(s) CARRO, FERNANDO INCERTIS	
	Examiner MaiKhanh Nguyen	Art Unit 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 October 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/21/05 & 8/6/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to Restriction Requirement and Preliminary Amendment filed 06/29/2009.

Claims 19-31 and 41-49 are presented for examination. Claims 1-18 and 32-40 have been cancelled. New Claims 41-49 have been added. Claim 19 is an independent Claim.

Election/Restrictions

2. Applicant's election with traverse of Group I (Claims 19-31) in the reply filed 06/29/2009 is acknowledged. The traversal is on the ground(s) that the search and the examination of the entire application could be made without serious burden. This is not found persuasive because these inventions are distinct and have acquired separate status in the art as shown by their different classification. In this case, Invention I determined to be classified in 715/255 and Invention II determined to be classified in 707/10. Thus, the requirement is still deemed proper and is therefore made FINAL.

Oath/Declaration

3. The Office acknowledges receipt of a properly signed Oath/Declaration submitted 10/25/2008.

Priority

4. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d), and based on application # 03368057.0 filed in EUROPEAN PATENT OFFICE (EPO) on 06/26/2003, which papers have been placed of record in the file.

Drawings

5. The drawings filed 10/25/2008 are accepted by the examiner.

Information Disclosure Statement

6. The Applicant's Information Disclosure Statements, filed 12/21/2005 and 08/06/2007, have been received, entered into the record, and considered. See attached form PTO 1449.

Specification

7. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code for example at page 4, lines 6-19.

Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 19-20, 22-26, 30, 31, 41-43, and 47-49 are rejected under 35 U.S.C. 102(b) as being anticipated by **Carro** (US 20010056439, Publication Date: December 27, 2001).

As to Claim 19:

Carro teaches a method for processing a physical document (*See the Abstract*), said method comprising:

- creating a record in a selections table stored in a user device, said creating the record comprising entering into the record: a document number that identifies both the physical document and an electronic document that is an electronic copy of the physical document, a page number that identifies a page of the physical document and a corresponding page of the electronic document, and a network address of a server that stores the electronic document (*See [0068] through [0075]* → *the user assigns a reference number (identifier) to this document (e.g., 387) for identifying said document, writes this reference number (identifier) on the document, and creates a hyperlink table associated with the document and accessible from the workstation, said hyperlink table comprising the reference number of the document and other relevant*

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information related to the document such as title, author, ISBN (International Standard Book Number), or date. The hyperlink table may be stored within the user workstation or may be stored in an external memory accessible from the user workstation ... enters the page number where the item is marked in the hyperlink table of the document (e.g., 16), associates this item with a destination address within the communication network, this destination address identifying a server connected to the communication network and the information and/or services within this server the user wants to access);

- receiving, by the user device, an identification of where a selected region within the page of the physical document is located within the page (*See [0087] –through [0102] → Selecting a Marked Item on this Page ... Determining the Position on the Page of the Point Pressed on the Touch Foil ... sends a signal to the user workstation to identify to selected marked item. This signal indicates the position on the page of the point that has been pressed by the user on the touch foil*); and
- inserting the received identification into the record of the selections table (*See [0066] through [0077] → access the Web pages associated with a marked item on a document 309, the user touches with its finger 306 the touch foil 307 placed over or under the marked item 308 he wishes to select. The position of the marked item selected on the touch foil identifies the Web server 305 ... pressing the touch foil on marked items on this page (step 1205); reading and storing in a hyperlink table the coordinates of marked items on this page ... a*

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page have been defined in the hyperlink table associated with the document, the touch foil is placed over (or under) the page.)

As to Claim 20:

Carro teaches the identification identifies the coordinates of the vertices of a polygon drawn around the selected region (*See [0093] through [0098] → Determining the Position on the Page ... The touch foil sends a signal to the user workstation to identify to selected marked item. This signal indicates the position on the page of the point that has been pressed by the user on the touch foil. The generated signal is generally proportional to the coordinates (X/Y) of the point pressed.*)

As to Claim 22:

Carro teaches the electronic document is an exact replica of the physical document (*See [0057] – [0059] → a hard-copy document 101 (e.g., a book) ... The physical document 101 can be of any kind, for example, a newspaper, a geographic map, a novel book, a text book, a technical book, a commercial catalog or even any other type of engraved or printed surface ... the document can be paper, plastic, wood or other material.*)

As to Claim 23:

Carro teaches the user device is a stand-alone handheld computer device (*See [0062] –[0064] → TouchTek4 touchscreens are commonly used in hand-held personal information management systems, PDAs, mobile computing systems, automotive, diagnostics and telecom devices, and Internet appliances.*)

As to Claim 24:

Carro teaches sending selected data in the record of the selections table to a user workstation, wherein the selected data comprises the document number, the page number, and the network address (*See [0100] through [0108] → The information contained at the selected destination address (URL) can be displayed on the user workstation. As shown in FIG. 11, additional information (e.g., Document number, page number, marked item, foil coordinates and URL) related to the marked item selected by the user can be shown on the Web Browser along with the information retrieved from the Web Server.*)

As to Claim 25:

Carro teaches sending, from the user workstation across a network to the server at the network address, a request for the page of the electronic document, wherein the request specifies the document number and the page number; and receiving, by the user workstation from the server, the requested page of the electronic document

(See [0107] and [0108] → Retrieving and Displaying the requested Information and/or Service. The information contained at the selected destination address (URL) can be displayed on the user workstation. As shown in FIG. 11, additional information (e.g., Document number, page number, marked item, foil coordinates and URL) related to the marked item selected by the user can be shown on the Web Browser along with the information retrieved from the Web Server.)

As to Claim 26:

Carro teaches the request does not include any text or graphics comprised by the physical document other than the document number and the page number *(See [0071] → each document he receives, the user assigns a reference number (identifier) to this document (e.g., 387) for identifying said document, writes this reference number (identifier) on the document, and creates a hyperlink table associated with the document and accessible from the workstation, said hyperlink table comprising the reference number of the document and other relevant information related to the document such as title, author, ISBN (International Standard Book Number).)*

As to Claim 27:

Carro teaches transmitting, to a destination document, a copy of a region on the received page of the electronic document corresponding to the selected region on the physical document *(See [0054] through [0058].)*

As to Claim 30:

Carro teaches the network is an Internet Protocol network (*the Internet uses a language referred to as TCP/IP ... supports three basic applications on the Internet*), wherein the network address is an Uniform Resource locator (*A resource of the Internet is unambiguously identified by a Uniform Resource Locator*), wherein the server is a Web server (*Web Server*) (*See [0002] – 0010*), and wherein the electronic copy is a HyperText Markup Language document (*See [0112] → a newspaper or magazine, may be interested in seeing computer multimedia or TV video information ... is retrieved from the Web.*)

As to Claim 41:

Carro teaches receiving, by a user workstation from the user device, selected data from the record of the selections table stored in the user device, wherein the selected data comprises the document number that identifies both the physical document and the electronic document that is an electronic copy of the physical document, the page number that identifies the page of the physical document and the corresponding page of the electronic document, and the network address of the server that stores the electronic document; sending, from the user workstation across a network to the server at the network address, a request for the page of the electronic document, wherein the request specifies the document number and the page number; and receiving, by the user workstation from the server, the requested page of the

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electronic document (See [0068] through [0075] → the user assigns a reference number (identifier) to this document (e.g., 387) for identifying said document, writes this reference number (identifier) on the document, and creates a hyperlink table associated with the document and accessible from the workstation, said hyperlink table comprising the reference number of the document and other relevant information related to the document such as title, author, ISBN (International Standard Book Number), or date. The hyperlink table may be stored within the user workstation or may be stored in an external memory accessible from the user workstation ... enters the page number where the item is marked in the hyperlink table of the document (e.g., 16), associates this item with a destination address within the communication network, this destination address identifying a server connected to the communication network and the information and/or services within this server the user wants to access.)

As to Claims 42- 44, 47 and 48:

Refer to the discussion of Claims 25- 27, 30 and 22 above, respective, for rejections.

As to Claim 49:

Carro teaches a computer program product comprising a computer readable storage medium, said storage medium storing instructions for performing the method of claim 41 when said instructions are executed on the user workstation (See Claim 23.)

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Carro** in view of **Duwaer** (US 5402151, issued 03/28/1995).

As to Claim 21:

The combination of Carro with Duwaer teaches receiving the identification by the user device from a transparent Electro-Luminescent Digitizing Tablet while the transparent ELDT is aligned over the page of the physical document and has sensed the identification from the polygon drawn over the transparent ELDT and around the selected region (*See Duwaer: Col. 4, lines 22 – Col. 5, line 9; and Col. 6, line 38-Col. 8, line 63.*)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Carro with Duwaer because it would have provided the

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capability for selecting and accessing multimedia information and/or services located on one or a plurality of servers connected to a communication network simply by touching with a finger items marked on a physical document or on any other physical surface.

Claims 28, 29, 45 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Carro** in view of **Dymetman** et al. (US 6330976).

As to Claim 28:

The combination of Carro with Dymetman teaches marking, by a plug-in program resident on the user workstation, the selected region on the received page of the electronic document; and copying the marked region into a destination document
(See Dymetman: Col. 28, lines 18- Col. 30, line 13.)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Carro with Duwaer because it would have created hyperlinks from physical documents (manuscripts or printed documents) to locally or remotely accessible servers and for triggering the hyperlinks simply by touching marked items (e.g., words, pictures, foot notes, symbols, icons) on said physical documents.

As to Claim 29:

The combination of Carro with Dymetman teaches copying the marked region to a clipboard of an operating system in the user workstation; and pasting the marked region on the clipboard into the destination document (*See Dymetman: Col. 28, lines 18- Col. 30, line 13.*)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Carro with Duwaer because it would have created hyperlinks from physical documents (manuscripts or printed documents) to locally or remotely accessible servers and for triggering said hyperlinks simply by touching marked items (e.g., words, pictures, foot notes, symbols, icons) on said physical documents.

As to Claims 45 and 46:

Refer to the discussion of Claims 28 and 29 above, respective, for rejections.

Conclusion

10. The prior art made of record, listed on PTO 892 provided to Applicant is considered to have relevancy to the claimed invention. Applicant should review each identified

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reference carefully before responding to this office action to properly advance the case in light of the prior art.

Contact information

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (571) 272-4093. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Hutton can be reached at (571) 272-4137.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like

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assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Maikhanh Nguyen/
Examiner, Art Unit 2176

/Laurie Ries/
Primary Examiner
Technology Center 2100
20 July 2009